

REMARKS

Independent claims 1, 11 and 21 are amended. Upon entry of the amendment, claims 1 - 28 are presented for consideration by the Examiner.

Claim 1 recites in pertinent part as follows:

a mounting bracket extending **laterally** from said body **axially below said lip** for mounting said base module to a vehicle;

a communication module receivable in said body central axial opening at a plurality of angular orientations to said body, said communication module including a skirt which mates with said lip **to define an annular interface**, an inlet conduit extending axially into said receptacle, a corresponding inlet fitting defining a fluid passageway extending away from said receptacle and an outlet fitting defining a fluid passageway extending away from said receptacle,

wherein **said body axially terminates at said lip**, said communication module is received in said body and fixed **at said annular interface** to said body at an angular orientation selected from any of said plurality of angular orientations to form said base module.

Claims 1 - 10 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,484,527 to Janik et al (hereinafter Janik) in view of U.S. Patent No. 2,418,777 to Le Clair (hereinafter Le Clair). In his rejection, the Examiner emphasizes that the angular orientation shown in the drawings of Janik depicting a connected body and communication module illustrate the claimed "selected angular orientation". In response, Applicant respectfully directs the Examiner's attention to the language of claim 1 which recites "said communication module is received in said body and fixed at said annular interface to said body at an angular orientation selected from any of said plurality of angular orientations to form said base module". The language of claim 1 emphasizes a location for fixing the body to the communication module, e.g., "at said annular interface". Additionally, the language of claim 1 emphasizes that the body and communication module are fixed at an angular orientation "selected from any of said plurality of angular orientations". Janik clearly discloses an arrangement

where parts are manufactured to be secured at a single angular orientation. The Examiner emphasizes that Janik might be modified to permit fixture of the body and communication module at angular orientations other than the illustrated angular orientation by reconfiguring one component or the other to permit passage of fasteners at the selected angular orientation. This proposed modification of Janik is contrary to the disclosure of that patent. Janik discloses that, "variations in filter base design are accommodated in the upper custom member, the lower generic member has a generic design". Janik emphasizes that the molded components "require no additional machining or treatment prior to use, thereby eliminating the machining and treating jigs and fixtures and production line changeovers heretofore required" (Janik, column 1, lines 49 - 58). Clearly, Janik does not contemplate adding machining steps to the assembly of the base module to accommodate fixture of the two components at a range of angular orientations.

Further, claim 1 is amended to emphasize that the mounting bracket extends "laterally from said body axially below said lip" and "wherein said body axially terminates at said lip". These structural limitations require a body configuration not disclosed, taught or suggested in Janik or the other art cited by the Examiner. The recited body configuration permits 360° freedom of movement for the received communication module relative to the base. Janik discloses a base 12 in which a mounting bracket extends upwardly on one side above the opening in which the communication module is received. This configuration clearly limits the useful range of received positions for the communication module. Clearly, the communication module of Janik cannot be fixed to the base of Janik at an angular orientation selected from "any of said plurality of angular orientations" at which the communication module is receivable in the base as required by the claim language of claim 1.

In his rejection of claim 1, the Examiner admits that Janik does not disclose, teach or suggest the coaxial lip recited in claim 1 and its relationship with a skirt configured to mate with the lip. The Examiner combines Janik with

Le Clair to arrive at Applicant's invention. In constructing this rejection, the Examiner impermissably employs Applicant's specification and claims as a roadmap for a combination of prior art structures. There is no disclosure, teaching or suggestion in either Janik or Le Clair that the structural features of those references can or should be combined to provide the structures and relationships recited in claim 1. Janik does not disclose, teach or suggest the need for a mated skirt and lip arrangement as recited in claim 1. One of skill in the art in possession of Janik would not look to the much older and structurally more complex Le Clair reference for guidance in providing the flexible structure recited in claim 1.

For all the foregoing reasons, claim 1 is patentable over the Examiner's proposed combination of Janik with Le Clair.

Claims 2 - 11 are patentable for at least the reasons stated in support of claim 1.

Claim 3 recites in pertinent part, "wherein said communication module skirt fits closely over said body annular lip forming a joint". Claim 3 recites a particular structure including an axially extending lip from claim 1 surrounded by and overlapping with the communication module skirt to form a joint. This configuration is not disclosed, taught or suggested by Janik or Le Clair either alone or in combination. Claim 3 is patentable for at least this additional reason.

Claims 11 - 20 are rejected under 35 U.S.C. §103(a) as being obvious to one of skill in the art over a combination of Janik and U.S. Patent No. 4,452,695 to Schmidt (hereinafter Schmidt).

Claim 11 recites in pertinent part as follows:

a body defining a cartridge receptacle and a central opening **through one axial end of said body said body including** a mounting bracket **laterally** extending from said body for mounting said base module to a vehicle;

a communication module configured to be received in said central opening and comprising inlet and outlet conduits extending axially into said receptacle and corresponding inlet and outlet connectors extending axially away from said receptacle, said

connectors being in fluid communication with said inlet and outlet conduits,

wherein said communication module is receivable in said central opening at a **360° continuum** of angular orientations to said body and fixable to said body at any of said **continuum** of angular orientations.

Claim 11 recites a particular location for the mounting bracket, e.g., "laterally extending from said body". Claim 11 also emphasizes that the "communication module is receivable in said central opening at a 360° continuum of angular orientations to said body and fixable to said body at any of said continuum of angular orientations". As discussed in greater detail above, the structures disclosed in Janik are not compatible with the flexibility required by the recitations of claim 11. The upwardly extending mounting bracket disclosed in Janik clearly blocks reception and fixture of the communication module to the base at the recited "360° continuum of angular orientations" recited in claim 11. Claim 11 is patentable over the Examiner's proposed combination of Janik with Schmidt. The Examiner does employ Schmidt to teach the "inlet and outlet connectors extending axially away from said receptacle". Schmidt does not disclose, teach or suggest a "body" and "communication module" having the configurations and functionality recited in claim 11. More importantly, there is no suggestion or motivation for one of skill in the art to combine the reference teachings in the manner proposed by the Examiner. Janik does not imply the need for the recited axially extending inlet and outlet connectors. Janik proposes that changes in base module configuration can be accommodated in the molded custom member. Applicant has taken the concept of manufacturing flexibility to a new level by claiming a base module made up of generic "base" and "communication module" components which are fixable at a "360° continuum of angular orientations" where the communication module includes "inlet and outlet connectors extending axially away from said receptacle." The recited inlet and outlet connectors serve as generic fluid communication points for fittings recited in later claims. Janik

does not imply the need for reference to the disclosures of Schmidt. Claim 11 is patentable over Janik in view of Schmidt.

Claims 12 - 20 depend directly or indirectly from claim 11 and are patentable for at least the reasons stated in support of claim 11.

Claims 12 - 20 recite particular structures and functional relationships for inlet and outlet fittings configured to mate with the recited inlet and outlet connectors. The Examiner turns to Schmidt for a teaching of the recited structures and functional relationships. Again, the Examiner is employing a hindsight reference to the Applicant's specification and claims as a roadmap to assembling prior art references. This is clearly impermissible under United States patent examination procedure and relevant legal precedent. Janik clearly teaches that variations in filter base design are to be accommodated in the molded upper custom member. Janik discloses an upper custom member with integrally molded inlet and outlet fittings extending radially beyond the periphery of the base at a fixed angular orientation relative to the communication module. This configuration makes reception and fixation of the communication module at a 360° continuum of angular orientations as recited in claim 1 impossible. Further, Janik implies that alternative base module configurations would be accommodated in the molded custom member but does not disclose, teach or suggest the manner in which such modifications might be made. Schmidt teaches a complex, multi-part, pivoting, right-angle fitting 60. The right-angle fitting of Schmidt requires multiple machined metal parts and threaded apertures, while Janik emphasizes providing flexibility of manufacture at low cost. An engineer of skill in the art seeking to enhance the flexibility of Janik at low cost would not seek out the complex, expensive, pivoting, right-angle fitting disclosed in Schmidt.

The Examiner is reminded that MPEP §2143 and relevant legal precedent require more than an assertion that an invention is within the ordinary skill in the art or that references can be modified to arrive at an Applicant's invention. There must be some motivation in the references themselves or in the

knowledge available to one of skill in the art to make the proposed combination. Janik does not disclose, teach or suggest the need for the recited axially extending inlet and outlet connectors. An engineer of skill in the art in possession of Janik and unaware of Applicant's claims would not seek out the teachings of Schmidt and its complex, expensive, multi-part, swiveling connectors.

Claim 14 recites in pertinent part, "wherein said fittings are joined to said connectors by an ultrasonic weld". Clearly, Schmidt teaches away from a fitting joined to a connector by means that would fix the angular relationship between the fitting and the connector. On the contrary, Schmidt emphasizes the importance of the swiveling connector to installation and use of the disclosed bypass filter. Claim 14 is patentable over the Examiner's proposed combination of Janik and Schmidt for at least this additional reason.

Claim 18 recites, "wherein said fitting have an enlarged throat at one end thereof, said throat enclosing end portions of said inlet and outlet connectors". Neither Janik or Schmidt, either alone or in combination, disclose, teach or suggest the recited structural relationship between the fitting and connectors as recited in claim 18. Claim 18 is patentable for at least this additional reason.

Claim 21 was rejected under 35 U.S.C. §102(b) as being anticipated by Janik. Claim 21 recites in pertinent part as follows:

- a) providing a communication module having inlet and outlet fittings;
- b) providing a body adapted to receive and mate with said communication module in a **360° continuum of** angular orientations to said communication module;
- c) mating said communication module to said body at an angular orientation selected from said **continuum** of angular orientations; and
- d) joining said communication module to said body at said selected angular orientation.

Claim 21 emphasizes reception and mating of the communication module and body at a "360° continuum of angular orientations". Paragraphs c) and d) of

claim 21 require that the communication module and body be joined at an angular orientation "selected from said continuum of angular orientations." As previously discussed, the disclosures of Janik preclude mating and fixture of a communication module and base at a 360° continuum of angular orientations as required by claim 21. The upwardly extending bracket of the base disclosed in Janik precludes reception over a significant portion of the available angular orientations. Clearly, Janik contemplates accommodating base module changes in the molded custom member corresponding to the communication module of the present invention. Janik does not disclose, teach or suggest the recitations of claim 21. Claim 21 is therefore neither anticipated nor obvious in view of Janik.

Claim 22 was rejected by the Examiner under 35 U.S.C. §103(a) over Janik in view of Schmidt. As previously discussed, Janik does not disclose, teach or suggest the need for or possible utility of the axially extending inlet and outlet connectors recited in claim 22. One of skill in the art seeking to enhance the flexibility of the base module disclosed in Janik would not seek out the complex and expensive swivel connectors disclosed in Schmidt. The recited axially extending inlet and outlet connectors of claim 22 and their functional relationships, e.g., "said inlet and outlet fittings are separate components each adapted to mate with a corresponding connector in a plurality of angular orientations to said communication module" combined with method steps e) - h) recite a flexible manufacturing method not contemplated by Janik or Schmidt either alone or in combination. Specifically, Schmidt fails to disclose, teach or suggest fixture of the inlet and outlet fittings to their respective inlet and outlet connectors at particular angular orientations. In contrast, Schmidt emphasizes the importance of the disclosed swiveling connector. Janik implies that changes to the base module configuration would be accommodated in the molded custom member corresponding to the communication module of the present invention. The recitations of claim 22 are not disclosed, taught or suggested by the

Examiner's proposed combination of Janik and Schmidt. Claim 22 is patentable for at least these additional reasons.

Claims 23 - 28 depend directly or indirectly from claims 21 and 22 and are patentable for at least the reasons stated in support of claims 21 and 22.

For all the foregoing reasons, Applicant respectfully requests allowance of claims 1 - 28.

Respectfully submitted,

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